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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,249	08/02/2006	David G. Lenahan	10FY-120754	6429
30764 7590 04/29/2009 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448				
EXAMINER				
JACKSON, DANIELLE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,249

Applicant(s)

LENAHAN, DAVID G.

Examiner

DANIELLE JACKSON

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Drawings***

The drawings are objected to because reference characters "210", "300" and "400", etc. have been used to designate the canopy. References characters assigned to the same parts must be consistent in each figure, meaning each figure cannot have a different number for the same part. The references characters listed above are an example of a problem that occurs throughout all of the drawings and specification. The other instances have not been listed but must be corrected as well in order for the drawings to be in proper form. Any changes made to the drawings should also be reflected in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7, and 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "a concave, curved leading edge". The leading edge being concave is not supported by the specification. This limitation is NEW MATTER.

Claims 1, 3-7, 9-12, 14-21 and 23-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "a concave, curved leading edge". As the leading edge being concave is not supported by the specification, one of ordinary skill would not know to make the leading edge concave based on the disclosure.

Claim 13 recites "an alignment gauge". The alignment gauge is mentioned in the specification, but not described in a manner that is clear and easy to comprehend. One of ordinary skill would not know how the alignment gauge functions given the description in the disclosure nor would one understand how to make such an "alignment gauge".

Claim 27 recites "a visor extension". An actual visor extension is never disclosed in the specification – it only refers to a "visor extension length"; therefore the actual visor extension itself is not describe and it's purpose/structure are not clearly stated. One of ordinary a skill would not know how to form a visor extension on a preexisting asymmetrical canopy.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-7, 9-12, 14-21 and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a concave, curved leading edge". It is unclear what it meant by a concave edge. It is not understood how a curved edge can be construed as concave or what orientation would make the edge concave. It appears in the drawings that the edge is actually convex.

Claim 27 recites "a visor extension". This would lead to believe there is a separate extension element; however this extension appears to be part of the

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asymmetrical canopy. What specific aspect of the canopy is considered the visor extension? And how is that separate from the regular canopy?

Claims 4, 7, 18 and 21 recite the limitation "the one or more traversal support members" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is unclear if these are the same support members recited in claim 27.

Claims 5 and 6 recite the limitation "at least one of the one or more support ribs" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is unclear if these are the same as the same support members recited in claim 27.

Claims 9 and 23 recite the limitation "the pliable material" inline 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-12, 14, 16-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201).

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Earnshaw et al. discloses a canopy for a stationary covering device comprising: a covering having asymmetrical positioned vertex point (3) from which the cover projects with unequal extension (not shown, but taught in column 4, lines 43-59), the canopy being rotatable around a fixed longitudinal axis, vertical support (4, 5) which can be tilted (see FIGS. 2-3), relative to the ground to provide an adjustable coverage zone within a desired stationary area when rotated from a first canopy position to a second canopy position at an elevation level relative to the ground. Furthermore, Earnshaw et al. discloses a one or more traversal support members, or support ribs (7).

Earnshaw et al. is silent on the specifics of the canopy, such as the leading edge and the material used to make the canopy, as well as the means by which the canopy be made asymmetrical. Kida discloses an umbrella comprising: a single pliable cloth cover (35) having an asymmetrical positioned vertex point (2) from which the cover projects with unequal extensions (FIG. 4). Kida teaches support ribs that traverse the cover, wherein some of the support ribs have a fixed length (3) and some of the support ribs have a variable length (18) where they are adjusted by an extendible member (FIG. 1(a)) to create a visor extension as best understood. Kida further discloses a concave curved leading edge (as seen in FIG. 4), wherein the canopy between the support ribs appears to have a concave shape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Earnshaw et al. to include extendable support members that support a canopy made of pliable cloth, as suggested by Kida, so that the shape and size of the canopy could be

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changed to various configurations in an easy convenient manner, therefore eliminating the need to obtain a whole new-shaped canopy.

Regarding claims 11 and 25, both Earnshaw et al. and Kida are discussed above but are silent on the asymmetry ratio of the unequal extensions, however it would have been obvious to one of ordinary skill in the art to modify Earnshaw et al. to provide a canopy with a ratio in a range between 1.5:1 and 2.3:1 measured horizontally in plan view. Every asymmetrical umbrella has a ratio of extended ribs to fixed ribs and the particular ratio would have been an obvious matter of design choice within the skill of the art because the particular ratio presents no novel or unexpected result.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201) as applied to claim 12 above, and further in view of Ma (US-2002/0129847 A1).

The combination of Earnshaw et al. and Kida discussed above but lacks the support mechanism comprising a cantilevered support at the vertex point by a projection from above the canopy. Ma shows a canopy having a canopy (15) that is supported by a projection (16) located above the canopy that is attached to a cantilevered support (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Earnshaw et al. and Kida to include a cantilevered support mechanism that attaches to a point above the canopy, as suggested by Ma, so there will not be an undesired support mechanism under the canopy.

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Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201) as applied to claim 28 above, and further in view of Freedman (US-2004/0134526 A1).

The combination of Earnshaw et al. and Kida discussed above but lacks an alignment gauge. Freedman discloses an umbrella having a canopy with photosdetectors (58, 59) that send signals to automatically move the umbrella so that is angled to get maximum protection from the sun (as seen in FIG. 5 and 6; paragraph 37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Earnshaw et al. and Kida to include an alignment gauge, as suggested by Freedman, so that the umbrella has means for realizing the optimal angle for ultimate sun protection.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Freedman (US-2004/0134526 A1).

Earnshaw et al. discloses a canopy for a stationary covering device comprising: a covering having asymmetrical positioned vertex point (3) from which the cover projects with unequal extension (not shown, but taught in column 4, lines 43-59), the canopy being rotatable around a fixed longitudinal axis, vertical support (4, 5) which can be tilted (see FIGS. 2-3), relative to the ground to provide an adjustable coverage zone within a desired stationary area when rotated from a first canopy position to a second canopy position at an elevation level relative to the ground; and a fixed support mechanism (1) for positioning the canopy relative to the elevated level.

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Earnshaw et al. lacks an alignment gauge. Freedman discloses an umbrella having a canopy with photosdetectors (58, 59) that send signals to automatically move the umbrella so that is angled to get maximum protection from the sun (as seen in FIG. 5 and 6; paragraph 37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Earnshaw et al. to include an alignment gauge, as suggested by Freedman, so that the umbrella has means for realizing the optimal angle for ultimate sun protection.

Response to Arguments

Applicant's arguments with respect to claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE JACKSON whose telephone number is (571)272-2268. The examiner can normally be reached on Monday through Friday 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on (571) 272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. J./

Examiner, Art Unit 3636

/DAVID DUNN/

Supervisory Patent Examiner, Art Unit 3636